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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,217	09/25/2001	Kaoru Indoh	214129US0XPC	8456

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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/18/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,217

Applicant(s)

INDOH ET AL.

Examiner

Keith Hendricks

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

i) Claim 1, and thus claims 3-5, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants' specification and original claims describe a range of "7-24% salt water." Applicants have amended the claims to recite "7-22% salt water." This range is not supported by the original specification, such that the amounts above 22% up to and including 24%, are excluded. The specification provides examples of both 22% and 24% as specific individual points; however, it does not provide support for a subset "7-22% salt water" from the originally-disclosed range of "7-24% salt water." Equally, nor would it provide support for the intrinsic excluded subset of "above 22% up to and including 24%", and although this subset is not claimed or set forth by applicant, neither new range would be supported by the original disclosure. If applicant wished to claim the use of a specific percentage point, i.e. 22%, this would be supported. However, applicants are cautioned against raising new issues of search and consideration After Final.

The burden now shifts to applicant to demonstrate possession of the later-claimed range, at the time the invention was made. The range not having been specifically named or mentioned in any manner, one is left to the selection from the myriads of possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made, rather than any of the many others which could also be made. Where a later claimed invention is not specifically named or mentioned in the specification as filed, the fact that there may even be some motivation for a person of skill to want to make it, and that such person would be enabled by the specification to make it, *is not relevant* to the point as to whether the original specification conveys to those skilled in the art, in any way, the information that applicant had invented this later-claimed invention. See *In re Wertheim*, 191 USPQ 90 (CCPA 1976).

Art Unit: 1761

ii) Claims 3 and 5 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Page 6 of applicants' specification provides for the fermentation time of "one month at 10°C and subsequently for a further 1-2 months at 20°C." In fact, Example 1, at page 8, utilizes just such a time frame. However, the specification does not provide support for a fermentation time of "*about* one month at 10°C...", as claims 3 and 5 are currently amended. This expands the interpretation and scope of the invention, to include times both longer and shorter than one month, which were not described or contemplated by the instant specification. Further, it is unclear as to what amounts of time would be encompassed by the period of "about one month." Applicant may not alter the information from that as originally filed, simply to suit some future purpose. Finally, this phrase does not find support at page 9, or page 11, or from the tables therein. The phrases "0-1 month" and "1-3 months" indicate the lengths of time at which the temperatures of the fermentation are conducted as indicated below in the charts. "0-1 month" is synonymous with the fermentation temperature for the first month, i.e. "one month at 10°C", and similarly, "1-3 months" indicates the temperature used from the end of the first month to the end of the third month, i.e. "subsequently for a further 1-2 months at 20°C."

Deletion of the term "about" from claims 3 and 5, is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata et al. (US PAT 5,665,407). The reference is taken as cited of record.

Art Unit: 1761

Applicants' arguments filed October 02, 2002, have been fully considered but they are not persuasive. At page 3 of the response, applicants state that the claims now recite "7-22% salt water being employed in an amount of 1.35 have [sic] 1.65 time the weight of the raw material mixture." "While such limitations may be within the broad scope of Nagata et al., nevertheless, such is not identically disclosed therein." Applicants further state that, in view of a potential forthcoming obviousness rejection, page 6 of the specification and Table 3 at page 10, demonstrate "result-effectiveness due to this claim limitation", which is neither disclosed nor obvious.

This is not deemed persuasive for the reasons of record and the teachings of the reference. Regarding the percentage of salt water, applicants' claims recite a range of 7-22%, whereas the reference utilizes 23%. Applicants' specification demonstrates no difference between these two amounts. While the reference does not specifically demonstrate the properties of the product when 7-22% salt water is utilized, the claimed invention still does not provide for an *unexpected* result. Further, the slight alteration of salt content would have been expected to have a corresponding and parallel change in the resultant product, regarding such factors as total nitrogen (TN), JAS color, and Glu/TN content, which were addressed in the reference, for example, at Tables 1 and 2. Obviously, the proportion of the starting materials would naturally affect the resultant outcome, and in logical, linear fashion with regard to the percentages of the components used therein. The reference claim 1 broadly provides for "adding to the koji product an aqueous solution of common salt to form a salt-containing koji product", and applicants themselves have admitted on the record that "such limitations may be within the broad scope of Nagata et al." Thus, the use of an amount of salt, for example at 22%, would not have been expected to produce a *patentable* difference over that exemplified in the reference, to 23%. One of ordinary skill in the art would have recognized this factor, and it would have been obvious to have modified the amounts of salt concentration in the water, especially in light of the fact that the water amounts and moisture contents were disclosed in broad ranges, as well. These ranges and amounts appear to fall within applicants' claims of 1.35-1.65 times the weight of the raw material mixture. Note that the claims do not require the presence of two of the three raw materials (soy and wheat at a possible 0%), thus affecting the percentage amount of water utilized therein, as well.

Art Unit: 1761

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KEITH HENDRICKS
PRIMARY EXAMINER